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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,341	11/27/2001	Cecily Anne Snyder	020313-001810US	1973

20350   7590   03/09/2007
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ART UNIT	PAPER NUMBER
3694	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	03/09/2007	PAPER

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PTOL-90A (Rev. 10/06)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Application Number: 09/996,341
Filing Date: November 27, 2001
Appellant(s): SNYDER, CECILY ANNE

MAR 0 9 2007

GROUP 3600

William J. Daley (Reg. No. 52,471)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 26, 2006 appealing from the

Office action mailed August 10, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,859,806	KAMAREI et al.	2-2005
7,016,852	LEE	3-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, and 5-20 are rejected under 35 U.S.C. 102(e) as being anticipated

by Kamarei et al. (U.S. Patent No. 6,859,806).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamarei

et al. (U.S. Patent No. 6,859,806), as applied to claim 1 above.

Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kamarei et al. (U.S. Patent No. 6,859,806), as applied to claim 1 above, in view of Lee

(U.S. Patent No. 7,016,852).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1, 2, and 5-20 are rejected under 35 U.S.C. 102(e) as being anticipated

by Kamarei et al. (U.S. Patent No. 6,859,806).

Kamarei discloses a computer-implemented method of generating a message for

a first intellectual property case, the method comprising:

[Claim 1]   storing information related to a plurality of intellectual property cases on a

computer-readable medium, the plurality of intellectual property cases including the first

intellectual property case (col. 5, lines 19-31 – Docketed cases are related to cases filed with a governmental office, such as a patent or trademark office; col. 6, line 49 – Case Listing Database; col. 10, lines 6-10 – Cases can be searched for and retrieved from a Case Listing Database, which implies that there are a plurality of cases stored), wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the intellectual property case and one or more documents related to the first intellectual property case (Fig. 6; col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9; Kamarei specifically states that "the Governmental System appends an electronic document, in ASCII, Word Perfect, MS Word, GIF, JPG, PDF, or any other type of format to the Docket Request Message." (Col. 10, lines 64-67) Furthermore, various documents may be generated in relation to a case (col. 11, lines 40-67; col. 13, lines 55-63). The docket request messages are case specific, have related documents, and are managed as a case data unit by a case management system (as seen in Fig. 6); therefore, Kamarei's case data unit stores data related to the intellectual property case and one or more documents related to the first intellectual property case);

receiving a signal indicating occurrence of an event related to the first intellectual property case (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

responsive to receiving the signal, identifying one or more rules associated with the event (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

identifying at least a first rule from the one or more rules based upon filter criteria

information associated with the one or more rules and based upon information related to

the first intellectual property case stored on the computer-readable medium (col. 8, line

45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

generating at least one message using the at least first rule, the message

identifying an action to be performed in response to the event and identifying a date

associated with the action (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through

col. 10, line 9); and

communicating the at least one message to a first designated client system (col.

9, line 64 through col. 10, line 2);

[Claim 2]   wherein the plurality of intellectual property cases includes patent cases

and the first intellectual property case is a patent application case (col. 9, lines 6-10 –

The case may be related to patent prosecution);

[Claim 5]   wherein the signal indicating occurrence of the event related to the first

intellectual property case is generated responsive to a change in the information related

to the first intellectual property case (col. 12, lines 1-34);

[Claim 6]   wherein identifying the at least first rule from the one or more rules based

upon the filter criteria information comprises:

determining a set of rules from the one or more rules associated with the event,

wherein a rule from the one or more rules is included in the set of rules if the filter

criteria associated with the rule is satisfied by the information related to the first

intellectual property case, the set of rules including the at least first rule (col. 8, line 45

through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 7]   wherein the plurality of intellectual property cases includes patent cases

and the first intellectual property case is a patent application case; and

the filter criteria associated with each rule in the one or more rules comprises a

criterion related to filing status of a patent case, a criterion related to a type of the patent

case, and a criterion related to priority information for a patent case (Fig. 6; col. 8, line

45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 8]   wherein generating the at least one message using the at least first rule

comprises:

determining an action associated with the at least first rule (col. 8, line 45 through

col. 9, line 2; col. 9, line 32 through col. 10, line 9);

determining a date generation formula associated with the action and a base

date used by the date generation formula (col. 8, line 45 through col. 9, line 2; col. 9,

line 32 through col. 10, line 9);

applying the date generation formula to the base data to generate the date

associated with the action (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through

col. 10, line 9); and

including information indicating the action associated with the at least first rule

and the date generated by applying the date generation formula in the at least one

message (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 9]   wherein communicating the at least one message to the first designated

client system comprises:

determining one or more users associated with the first intellectual property case

from information related to the first intellectual property case (col. 9, line 64 through col.

10, line 2);

from the one or more users, determining a first user who is designated to receive

the at least one message generated using the first rule (col. 9, line 64 through col. 10,

line 2);

communicating the at least one message to a system used by the first user (col.

9, line 64 through col. 10, line 2);

[Claim 10]   wherein communicating the at least one message to the system used by

the first user comprises:

sending an electronic mail message to first user, the electronic mail message

including the at least one message (col. 9, line 64 through col. 10, line 2).

[Claims 11-20]   Claims 11-20 recite limitations already addressed by the rejection

of claims 1, 2, 4, 6, 8, and 9 above; therefore, the same rejection applies.

It should be noted that Kamarei uses a processor and memory to perform the

recited functionality (col. 5, lines 19-31; col. 5, line 41; col. 6, lines 38-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamarei

et al. (U.S. Patent No. 6,859,806), as applied to claim 1 above.

[Claim 3]   Kamarei teaches that the plurality of intellectual property cases includes

trademark cases (col. 9, lines 6-10), yet Kamarei does not expressly teach that the

cases may be copyright cases. However, Official Notice is taken that it is old and well-

known in the art of intellectual property to prosecute copyright cases. Kamarei is open

to managing various types of transactions with governmental systems (col. 5, lines 26-

28) and copyrights are obtained through a government office, such as the U.S.

Copyright Office; therefore, the Examiner submits that it would have been obvious to

one of ordinary skill in the art at the time of Applicant's invention to adapt Kamarei to

assist in the management of copyright dockets in order to expand the marketability of

Kamarei's invention, thereby increasing the likelihood for profit.

Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kamarei et al. (U.S. Patent No. 6,859,806), as applied to claim 1 above, in view of Lee

(U.S. Patent No. 7,016,852).

[Claim 21]   While Kamarei stores case-related documents (as discussed above),

Kamarei does not expressly teach that the one or more documents comprise one or

more documents selected from the group consisting of: an invention disclosure, a filed

patent application, a patent drawing, an old version of a patent application, an office

action, and a response to an office action; however, the differences in the types of

documents are only found in the non-functional descriptive material and are not

functionally involved in the steps recited nor do they alter the recited structural

elements; therefore, such differences do not effectively serve to patentably distinguish

the claimed invention over the prior art. The recited method steps would be performed

the same regardless of the specific data. Further, the structural elements remain the

same regardless of the specific data. Thus, this descriptive material will not distinguish

the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703*

F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32

USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, Lee discloses a docket

management system that formats and stores documents (e.g., documents to be filed

with an intellectual property office, such as the specification, claims, abstract, and

drawings of a patent application) (col. 7, lines 1-5, 18-67). Both Kamarei and Lee are

directed toward intellectual property docket management systems; therefore, the

Examiner submits that it would have been obvious to one of ordinary skill in the art at

the time of Applicant's invention to modify Kamarei such that the one or more

documents comprise one or more documents selected from the group consisting of: an

invention disclosure, a filed patent application, a patent drawing, an old version of a

patent application, an office action, and a response to an office action in order to

facilitate more efficient and rapid collaboration among various parties in an effort to

transact with an intellectual property office (which is a general goal of both Kamarei, as seen in col. 4, lines 39-54, and Lee, as seen in col. 3, lines 17-64).

Regarding claims 22 and 23, Kamarei does not expressly teach the steps of storing the one or more documents comprising storing each document as part of a document entity that comprises the document and a set of meta-data about the document (claim 22), wherein the set of meta-data about the document comprises one or more data elements selected from the group consisting of a document ID, a document type, an originator, a status, a security profile, a file format, a creation date, a last modified date, a set of physical file attributes, a set of search field key words, a completion date, and a list of witness names (claim 23) and scanning a paper to produce a scanned document in a computer readable format, wherein storing one or more documents comprises storing the scanned document (claim 24). However, Lee discloses that the documents may be scanned (col. 11, lines 18-21; col. 13, lines 4-7) and stored in a format that defines the document's meta-data corresponding to the document's physical file attributes and file format (col. 12, lines 12-36). Again, both Kamarei and Lee are directed toward intellectual property docket management systems; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Kamarei to perform the steps of storing the one or more documents comprising storing each document as part of a document entity that comprises the document and a set of meta-data about the document (claim 22), wherein the set of meta-data about the document comprises one or more data elements selected from the group consisting of a document ID, a

document type, an originator, a status, a security profile, a file format, a creation date, a

last modified date, a set of physical file attributes, a set of search field key words, a

completion date, and a list of witness names (claim 23) and scanning a paper to

produce a scanned document in a computer readable format, wherein storing one or

more documents comprises storing the scanned document (claim 24) in order to

facilitate more efficient and rapid collaboration among various parties in an effort to

transact with an intellectual property office (which is a general goal of both Kamarei, as

seen in col. 4, lines 39-54, and Lee, as seen in col. 3, lines 17-64). Also, Lee implies

that scanning documents facilitates the collaborative approval of documentation and

submission thereof to an appropriate intellectual property office (col. 11, lines 7-21; col.

13, lines 2-21), which would be advantageous to Kamarei's intellectual property docket

management system for the same reasons since both Lee and Kamarei are ultimately

concerned with the goal of efficiently and quickly performing transactions with an

intellectual property office.

Additionally, as per claim 25, neither Kamarei nor Lee expressly teaches the step

of subjecting the scanned document to optical character recognition to recognize data

from one or more fields from the scanned document, wherein storing the data related to

the intellectual property case comprises storing the recognized data in the case data

unit; however, Official Notice is taken that it is old and well-known in the art of document

scanning to scan documents using optical character recognition. The use of optical

character recognition allows one to more easily extract a desired subset of data from

the scanned document. Since the Kamarei-Lee combination addresses the storage and

scanning of intellectual property related documents, the Examiner submits that it would

have been obvious to one of ordinary skill in the art at the time of Applicant's invention

to modify the Kamarei-Lee combination to perform the step of subjecting the scanned

document to optical character recognition to recognize data from one or more fields

from the scanned document, wherein storing the data related to the intellectual property

case comprises storing the recognized data in the case data unit in order to allow one to

more easily extract a desired subset of data from the scanned document, which can be

especially useful when filing patent applications and related documents electronically.

Regarding claim 26, Kamarei teaches the step of receiving a signal indicating

occurrence of an event related to the first intellectual property case (col. 8, line 45

through col. 9, line 2; col. 9, line 32 through col. 10, line 9), yet Kamarei does not

expressly teach that the signal indicating occurrence of the event related to the first

intellectual property case is generated responsive to the recognized data. However,

Kamarei's event reminders may be related to events that require the filing of a

document (as seen from the types of actions shown in Fig. 8). If a reminder to file a

document is generated (as seen in Kamarei) and documents needed to pursue patent

prosecution are scanned (as seen in the Kamarei-Lee combination), the Examiner

submits that the scanning of required documents would obviously allow one to respond

to the types of actions shown in Fig. 8 of Kamarei. For example, if an affidavit is due,

this implies that a document containing an affidavit needs to be filed. Therefore, the

Examiner submits that it would have been obvious to one of ordinary skill in the art at

the time of Applicant's invention to further modify the Kamarei-Lee combination such

that the signal indicating occurrence of the event related to the first intellectual property

case is generated responsive to the recognized data in order to more efficiently provide

reminders to file required documents related to an event reminder when these

documents become available.

(10) Response to Argument

Appellant argues that "Kamarei fails to teach a case data unit that stores one or

more documents related to an intellectual property case. Instead, Kamarei merely

teaches the storage of docketing information, along with triggering associated reminders

and deadlines." (Page 8 of the Appeal Brief) The Examiner respectfully disagrees.

First, it should be noted that Appellant specifically refers to the step of "storing

information related to a plurality of intellectual property cases on a computer-readable

medium, the plurality of intellectual property cases including the first intellectual property

case, wherein storing information related to the first intellectual property case comprises

storing the information related to the first intellectual property case in a case data unit,

wherein the case data unit stores data related to the first intellectual property case and

one or more documents related to the first intellectual property case." (Claim 1) The

particular type of information stored is never utilized for any purpose that specifically

requires this type of information. These differences are only found in the non-functional

descriptive material and are not functionally involved in the steps recited nor do they

alter the recited structural elements; therefore, such differences do not effectively serve

to patentably distinguish the claimed invention over the prior art. The recited method

steps would be performed the same regardless of the specific data. Further, the

structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); In re Ngai, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106.*

Additionally, the stored data is merely "related to" the first intellectual property case. By Appellant's own assertion, "Kamarei merely teaches the storage of docketing information, along with triggering associated reminders and deadlines" and "[a]s Kamarei discloses, '[t]he Action Prompt 30 and Action Prompt Due Date (Not shown) provide the vehicle for notifying users of a Client System of the type of action that needs to be taken in the governmental proceeding and the time that such action should be taken, or a reminder in advance of the time an action should be taken.'...Clearly, the Action Prompt is merely a reminder system and has nothing to do with the storage of documents." (Page 8 of the Appeal Brief) Even, if as Appellant asserts, Kamarei is nothing more than a reminder system, Figures 6-8 of Kamarei clearly show that a user sets up various reminders that can be added and/or updated in relation to a particular case, which means that such reminder information is stored in relation to its respective case. These reminders are indicative of information (e.g., deadlines) "related to" (i.e., "associated with" or "linked to") a plurality of intellectual property cases; therefore, the stored reminders themselves address the limitation in question. (The fact that a case is

identified by case number and application number, as seen in Figure 8, as well as the

fact that a "New Case" option is provided, as seen in Figure 7, imply that there are a

plurality of cases to be managed.)

Additionally, the limitation "wherein the case data unit stores data related to the

first intellectual property case and one or more documents related to the first intellectual

property case" can be interpreted as "wherein the case data unit stores data related to

the first intellectual property case and data related to one or more documents related to

the first intellectual property case." Again, the reminders are associated with/linked

to/related to case-specific information, such as due dates for documents (e.g., see

"Appeal," "Affidavit Due," "Power of Attorney," and "Priority Documents" in Figure 6).

Furthermore, the Examiner submits that Kamarei does store actual documents

related to a plurality of intellectual property cases. Notably, the storing step (e.g., of

claim 1) does not specify where such information is stored (beyond the fact that it is

stored in a computer-readable medium). Kamarei incorporates action prompts to

search for a document (col. 8, line 63), which also suggests the existence of a

document related to a given case. Also, Kamarei specifically states that "the

Governmental System appends an electronic document, in ASCII, Word Perfect, MS

Word, GIF, JPG, PDF, or any other type of format to the Docket Request Message."

(Col. 10, lines 64-67) Furthermore, various documents may be generated in relation to

a case (col. 11, lines 40-67; col. 13, lines 55-63). The docket request messages are

case specific, have related documents, and are managed as a case data unit by a case

management system (as seen in Fig. 6); therefore, Kamarei's case data unit stores data

related to the intellectual property case and one or more documents related to the first

intellectual property case. As a matter of fact, claims 1, 8, and 9 of Kamarei set forth

how a docket request message is used to access information related to a selected legal

case (which, in light of col. 5, lines 26-27 and Figures 6-8, is understood to be an

intellectual property case). Then, Kamarei's claim 8 brings in "a document generation

step wherein any one or combination of the following documents are created by the host

server system using information contained in the case listing database; legal

documents, action prompt reports, action prompt due date reports, client system defined

forms, and client system defined letters." Kamarei's claims 9 and 12 clarify how the

document may be prepared automatically and generated in response to defined search

parameters and claim 14 recites that "the document is electronically forwarded to any

one or combination of the following; the client system, a Government System, a third

party designated by the client system." This case-related document must be stored at

some point (even if only temporarily) in order to be created and forwarded electronically.

Additionally, claim 1 of Kamarei recites that the action prompt and computerized action

prompt due date for the legal case selected by the client system are recorded (i.e.,

stored). As seen in Kamarei's claim 8, case-related action prompt reports and action

prompt due date reports are documents that may be generated. Since the information

from these reports is stored (as seen in claim 1) and can be accessed or updated by

users (as seen in the reports displayed in Figures 6-8), these reports also serve as

examples of one or more documents related to the first intellectual property case that

are stored in a case data unit (as recited in Appellant's claim 1).

In conclusion, Appellant arguments are not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.
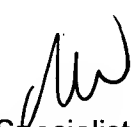
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